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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,409	06/15/2001	Hironori Kobayashi	DAIN:498A	8853
7590 12/30/2004 PARKHURST & WENDEL, L.L.P. 1421 Prince Street, Suite 210 Alexandria, VA 22314-2805			EXAMINER MCPHERSON, JOHN A	
			ART UNIT 1756	PAPER NUMBER
DATE MAILED: 12/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/882,409

Applicant(s)

KOBAYASHI ET AL.

Examiner

John A. McPherson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 82-146, 150-153 and 155-216 is/are pending in the application.

4a) Of the above claim(s) 83-95, 97-103, 106-113, 116-146, 150-153 and 155-216 is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 82, 96, 104, 105, 114, and 115 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/29/04 has been entered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 82, 96, 104, 105, 114 and 115 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,450,635 for the reasons of record as set forth in paragraphs 2 of the Office Action dated 8/1/03, and as further discussed below.

3. Claims 104 and 114 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,554,420, filed as copending Application No. 10/142,379 and published as U.S. Patent Application Publication 2002/0126194, for the reasons of record as set forth in paragraphs 3 of the Office Action dated 8/1/03, and as further discussed below.

4. Claims 104 and 114 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,294,313. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed invention is generic to the species claimed in the patent.

5. Claims 82, 96, 104, 105, 114 and 115 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,650,047. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed invention is generic to the species claimed in the patent.

6. Claims 104 and 114 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,573,650. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because the presently claimed invention is generic to the species claimed in the patent.

7. Claims 82, 96, 104, 105, 114 and 115 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-49 of copending Application No. 10/651,062, published as 2004/0046498. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed invention is generic to the species claimed in the patent.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 82, 96, 104, 105, 114 and 115 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 1 329 589 [listed on the Information Disclosure Statement filed 10/10/01] (GB '589) for the reasons of record as set forth in paragraphs 2 of the Office Action dated 8/1/03, and as further discussed below.

Response to Arguments

9. Applicant's arguments filed 12/31/03 have been fully considered but they are not persuasive.

With respect to the obvious double patenting rejections, Applicant argues that the examined claims don't relate to or embrace a concept of a color filter and a method of making the same utilizing an inkjet system. However, the examined claims clearly embrace the concept set forth in the patented claims, as they are generic to the patented species. The obvious double patenting rejection over US 6,554,420 has been limited to claims 104 and 114 because the claims of the patent do not include the silicon compound required in claims 82, 96, 105 and 115 of the present invention.

With respect to the rejection over GB '589, Applicant argues that the upper exposure limit is far too small to photoexcite titanium dioxide, however the reference discloses a medium, which is hydrophobic when unexposed and hydrophilic when exposed (page 1, lines 11-16), comprising a radiation-sensitive material such as the metal oxides of the present invention (page 1, lines 81-91 and page 3, lines 37-38). Furthermore, Applicants note that the reference was published in 1973, however it is the position of the Examiner that the age of the reference is irrelevant with respect to the anticipation of the presently claimed invention.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. McPherson whose telephone number is (571)

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272-1386. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John A. McPherson
Primary Examiner
Art Unit 1756

JAM
12/27/04